

REMARKS

This is in full and timely response to the final Office Action mailed June 11, 2003, submitted concurrently with a Petition for an extension of time to within the second extended month. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

By this amendment, claims 3-4 were amended to recite weight ratio as suggested by the examiner and supported variously throughout the specification. Claims 1 and 2 were amended to place these claims in better U.S. format, and allowing proper consideration of the preamble. Claim 5 was amended to an optical element having the primer composition of claims 1-4 as one of its layers. Claims 12-19 and 24-26 were amended to place in better method format reciting a method of forming an optical element. All of claims 12-19 contain the common special technical feature of the primer layer comprising thermoplastic polyester elastomer. Claim 27 was added to recite the method of using the primer composition of claims 1, 2, 3 or 4. Support for new claim 27 can be found variously throughout the specification, for example, original claim 5. No new matter was added. Claims 20-23 were canceled without prejudice of disclaimer to their underlying subject matter. Accordingly, claims 1-19 and 24-27 remain pending in this application, with claims 1-5, 12-19 and 24-27 pending for the Examiner's reconsideration, with claims 1, 12 and 24 being independent. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Restriction

The Office Action (Paper No. 8) comments on Group I/IV are appreciated. Applicants believe that the restriction between Groups I and IV and should be withdrawn at this time. Claims 1-2, 5, 12-19 and 24-26 have been amended to more clearly recite the common technical feature of the primer layer comprising thermoplastic polyester elastomer. This common technical feature was clearly identified by in the International Search Report, and has not been contradicted by the examiner.

This application is a National Phase of a PCT application under 35 U.S.C. §371, and is not an application filed under 35 USC 111(a). MPEP § 1893(d) points out that with respect to national

stage applications filed under 35 USC 371, restriction practice under 35 USC 121 is inapplicable. Rather, Unity of Invention practice under PCT Rule 13 and 37 CFR 1.475 applies. Accordingly, Restriction Requirements are governed under the Unity of Invention standards, and the examiner must clearly specify why the claims directed to different groups of inventions lack a common special technical feature. Namely, Unity of Invention exists when claims are directed to a common special technical feature. This is discussed in detail in Chapter 1800 of the MPEP. Examples concerning Unity of Invention are given in the Annex to the MPEP, specifically Part 2 of Annex B to the Administrative Instructions Under the PCT.

In this Office Action, by stating “had the Applicant claimed a method of adhering a silicone hardcoat to an optical element, and the article prepared by the method, these claims would have been inseparable according to PCT practice because the Examiner could not have easily demonstrated that the inventions lacked a common special technical feature.” However, this is a misstatement of the rules. Specifically, the examiner is clearly applying restriction practice under Rule 121 when he discusses apparatus and method of making. This is an improper analysis. Additionally, whether it is “easily demonstrated” or not is not a proper standard to be applied. However, this is de facto acknowledgement by the examiner that there is a single general inventive concept under PCT Rule 13.1.

In order to expedite prosecution, Applicants have amended claims 1-2, 5, 12-19 and 24-26 in order to regroup Groups I and IV, such that claims 1-5, 12-19 and 24-26 are joined in a single group having the common technical feature discussed above.

Accordingly, acknowledgement of the joining of Groups I and IV is requested.

Additionally, as this Restriction is improper, and no art rejections have been made against claims 5, 12-19 and 24-26, these claims are deemed allowable and in condition for allowance. Notice to that effect is hereby requested.

Rejections under 35 U.S.C. §112

Claims 3-4 are rejected under 35 U.S.C. §112, first paragraph. By this Amendment, claims 3 and 4 were amended to recite weight ratio instead of molar ratio as recited in the specification. Applicants thank the examiner for his helpful comments.

Withdrawal of this rejection is respectfully requested.

Claim Analysis

The examiners comments are noted. Claims 1-5, 12-19 and 24-26 have been amended to place the claims in more idiomatic English and in better form corresponding to U.S. practice. Accordingly, for example, claim 1 recites a primer composition that forms all or part of a primer layer between an organic glass base material and a silicone based hardening coating film comprising: a primer layer formation polymer; wherein the primer layer formation polymer is a polyester based thermoplastic elastomer, also known as ester based TPE. Accordingly, there is no intended use limitation, as the primer composition comprises a primer layer formation polymer, and the primer composition forms all or part of a primer layer between an organic glass base material and a silicone based hardening coating film.

Rejections under 35 U.S.C. §102

Claims 1 and 2 are rejected under 35 U.S.C. §102(b) as being unpatentable over U.S. Patent No. 5,704,854 to Higuchi et al. or JP 59-45349A (abstract) to Kuratsuji et al. Claim 1 is rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,242,560 to Gyobu et al.

Claim 1 recites a primer composition that forms all or part of a primer layer between an organic glass base material and a silicone based hardening coating film comprising: a primer layer formation polymer; wherein the primer layer formation polymer is a polyester based thermoplastic elastomer, also known as ester based TPE.

Higuchi et al. '854 clearly discloses a golf ball, as acknowledged by the examiner. As amended, when all of the elements are considered as well as their use, then this reference becomes moot, as there is no organic glass base material.

Kuratsuji et al. '349 discloses a polyether ester elastomer composition. As discussed above, this reference becomes moot when all of the elements are considered.

Gyobu et al. '560 discloses a thermoplastic polyester elastomer composition. As discussed above, this reference becomes moot when all of the elements are considered.

A document can only anticipate a claim if the document discloses, explicitly or implicitly, each and every feature recited in the claim. Verdegall Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Since Higuchi et al. '854 and Kuratsuji et al. '349 and Gyobu et al. '560 fail to disclose, either explicitly or implicitly, teach or suggest at least the above-noted elements recited in independent claim 8, Higuchi et al. '854 and Kuratsuji et al. '349 and Gyobu et al. '560 cannot anticipate the claims. At least in view of the foregoing, claim 1 is allowable, and the rejection should be reconsidered and withdrawn.

Additionally, claim 2, being dependent upon allowable claim 1, is also allowable for the reasons above. Moreover, these claims are further distinguished by the additional features recited therein, particularly within the claim combination.

Accordingly, withdrawal of the §102 rejection is respectfully requested.

Rejections under 35 U.S.C. §103

Claims 3-4 rejected under 35 U.S.C. §103(a) as being unpatentable over JP 59-45349A (abstract) to Kuratsuji et al.

Claim 3-4, being dependent upon allowable claim 1, are also allowable for the reasons above. Moreover, these claims are further distinguished by the additional features recited therein, particularly within the claim combination.

Accordingly, withdrawal of the §103 rejection is respectfully requested.

Conclusion

For the foregoing reasons, claims 1-4 are allowable, and claims 1-5, 12-19 and 24-27 are in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of these amendments and remarks is courteously solicited. If the examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

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Respectfully submitted,

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicant(s) hereby petition for any needed extension of time.

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